UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,925	03/31/2004	Sumit Agarwal	Google-66 (GP-238-00-US)	5061

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EXAMINER
RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 September 2009</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>7-24,26-30,48-65 and 67-76</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>7-24,26-30,48-65 and 67-76</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>5/13/09,8/11/09</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to amendment filed September 8, 2009. Applicant

amended claims 7-24, 26-30, 48-65, 67, 69-72, canceled claims 1-6, 25, 32-47, 66 and added

claims 73-76. Claims 7-24, 26-30, 48-65, 67-76 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-24, 26-30, 48-65, 67-76 rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 9 recites b) generating, by the computer system in response to the received search

query, a document including a plurality of search results, <u>each of the plurality of search results</u>

being linked to a linked document <u>associated with a domain identifier</u> such that when a user

selects a search result, the linked document is provided to the user; d) storing, by the computer

system in response to the received user selection of the one of the plurality of search results, an

association of <u>the domain identifier of the linked document</u> and information of the search query

h) <u>accepting</u>, by the computer system and as an advertiser input, <u>the domain identifier;</u>

The claim recites a plurality of search results and each result is associated with domain

identifier. The claim also recites that the step of a) thru d) are repeated. Therefore, there could be

more than one domain identifiers associated with user selections. It is unclear which of the

domain identifiers is inputted by the advertiser or accepted as an input.

Claim 9 also recites repeating acts a) through d). Does it mean that the same search query
(with the same term or phrase) is receiving again, and also the same search results for the same
search query is generated? If that is the case the same selection and the same association with the
same document identifier is stored, which implies that the aggregated data would only include
the same selection and same association.

Claims 17, 50, 58, 73-76 are also rejected for the same reason.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

Claims 9-14, 17-31, 50-55 and 58-72 are rejected under 35 U.S.C. 102(e) as being
anticipated by Ryan et al. (US 6,421,675 B2).

Regarding claims 9-11, 17, 19-22, 24, 26, 27, 50-52, 58-63, 65, 67-68, Ryan teaches:

a) receiving, by a computer system including at least one computer, a search query;

wherein the query includes term or phrase (see col. 6 lines 5-11);

b) generating, by the computer system in response to the received search query, a

document including a plurality of search results, each of the plurality of search results

being linked to a linked document (associated with a domain identifier) such that when a

user selects a search result, the linked document is provided to the user; wherein the

linked document is a web page; wherein the domain identifier is a URL (see col. 6 lines

10-52);

c) receiving, by the computer system, a user selection of one of the plurality of search

results (see col. 6 lines 10-52);

d) storing, by the computer system in response to the received user selection of the one of

the plurality of search results, an association of the domain identifier of the linked

document and information of the search query (see col. 6 lines 10-52);

e) repeating acts (a) through (d) (see col. 10 lines 46 to col. 12 line 67);

f) aggregating, by the computer system, stored associations of domain identifiers and

information of search queries to generate a set of aggregated domain identifier-to-search

query information associations (see col. 2 lines 25-56, col. 4 line 43-67, col. 11 line 6 to

col. 12 line 67);

g) storing, by the computer system, the set of aggregated domain identifier-to-search

query information associations, wherein the search query information includes at least

one of (A) one or more terms and (B) one or more phrases extracted from the search

query (see col. 11 line 1 to col. 12 line 67;

h) accepting, by the computer system and as an advertiser input, the domain identifier;

i) obtaining by the computer system using the accepted domain identifier at least one of

the (A) one or more terms and (B) one or more phrases from the stored set of aggregated

domain identifier-to-search query information associations (see fig. 15-23).

Regarding the claim language providing, by the computer system, the obtained

at least one of the (A) one or more terms and (B one or more phrases *as ad information stored in*

association with an ad, wherein the ad has a landing page document, and wherein the

landing page document belongs to a domain identified by the domain identifier; and k)

controlling, by the computer system, a serving of the ad using the at least one of the (A) one or

more terms and (B) one or more phrases stored in association with the ad as the targeting

information, no patentable weight is given to the bolded section. The claim language "*as ad*

information stored in association with an ad, wherein the ad has a landing page document,

and wherein the landing page document belongs to a domain identified by the domain

identifier" is just the intended use of the term or phrase. The claimed step of providing is for the

obtained term or phrase and if the provided term or phrase is treated as an ad information stored

in association with an ad or not does not change the step of providing the obtained term or

phrase. Therefore, the language does not patentably differentiate the claimed step from the prior

art. It has been held that language that suggests or makes optional but does not require steps to

be performed or does not limit a claim to a particular structure does not limit the scope of a claim

or claim limitation. The following are examples of language that may raise a question as to the

limiting effect of the language in a claim:

(A)   statements of intended use or field of use,

(B)   "adapted to" or "adapted for" clauses,

(C)   "wherein" clauses, or

(D)   "whereby" clauses.

This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

However if Examiner was to consider the limitation, Ryan also teaches as follows: in order for web pages (12) to be selected by a user, search input obtained from one of variety of sources is input and used along with the algorithm selected to determine search results; the result of the search are then displayed to the user, as shown by the steps of displaying web pages, and displaying actively suggested web pages … in order for keyword suggestion to take place ... which search algorithm to use is selected... Ryan further teaches the novel feature which indirectly inures to the benefit of the end user directly benefit the advertiser, because it allows for content to be targeted in real time based upon various criteria … based upon inputs from users and content providers, which content to show is determined; therefore, advertisements are displayed for the user to see, simultaneously with the display of either keywords and/or web pages (landing page) (see col. 4 lines 31-67, see also col. 30 lines 15-67)

Regarding claims 12-14 and 53-55, Ryan teaches the act of providing the one or more terms or phrases includes populating keyword targeting information of the ad; populating at least some content of a creative information of the ad; suggesting at least some content of a creative of the ad to an advertiser (col. 2 lines 25-56, col. 4 lines 43-67, col. 11 line 6 to col. 12 line 67).

Regarding claim 18, Ryan teaches wherein the association includes at least term count or phrase count (see col. 11 line 1 to col. 12 line 67).

Regarding claims 23 and 64, Ryan teaches wherein the search query information includes at last two of one or more terms and one or more phrases (see col. 11 line 1 to col. 12 line 67).

Regarding claims 28-31, 65, 69-72, Ryan teaches populating or suggesting the targeting information of the ad with at least a keyword; populating at least some content of a creative of

the ad; suggesting at least some content of a creative of the ad to an advertiser (col. 2 lines 25-56,

col. 4 lines 43-67, col. 11 line 6 to col. 12 line 67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 10, 11 and 73-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ryan et al. (US 6,421,675 B2) further in view of Horowitz et al. (US 2005/0097204 A1).

Regarding claims 73-76, Ryan teaches:

a) receiving, by a computer system including at least one computer, a search query

wherein the query includes term or phrase (see col. 6 lines 5-11); (see col. 6 lines 5-11);

b) generating, by the computer system in response to the received search query, a

document including a plurality of search results, each of the plurality of search results

being linked to a linked document (associated with a domain identifier) such that when a

user selects a search result, the linked document is provided to the user; wherein the

linked document is a web page; wherein the domain identifier is a URL (see col. 6 lines

10-52);

c) receiving, by the computer system, a user selection of one of the plurality of search

results (see col. 6 lines 10-52);

d) storing, by the computer system in response to the received user selection of the one of

the plurality of search results, an association of the domain identifier of the linked

document and information of the search query (see col. 6 lines 10-52);

e) repeating acts (a) through (d) (see col. 10 lines 46 to col. 12 line 67);

f) aggregating, by the computer system, stored associations of domain identifiers and

information of search queries to generate a set of aggregated domain identifier-to-search

query information associations (see col. 2 lines 25-56, col. 4 line 43-67, col. 11 line 6 to

col. 12 line 67);

g) storing, by the computer system, the set of aggregated domain identifier-to-search

query information associations, wherein the search query information includes at least

one of (A) one or more terms and (B) one or more phrases extracted from the search

query (see col. 11 line 1 to col. 12 line 67;

h) accepting, by the computer system and as an advertiser input, the domain identifier;

 i) obtaining by the computer system using the accepted domain identifier at least one of

the (A) one or more terms and (B) one or more phrases from the stored set of aggregated

domain identifier-to-search query information associations (see fig. 15-23).

Regarding the claim language <u>providing</u>, by the computer system, <u>the obtained</u>

<u>at least one of the (A) one or more terms and (B one or more phrases</u> *as ad information stored in*

association with an ad, wherein the ad has a landing page document, and wherein the

landing page document belongs to a domain identified by the domain identifier; and k)

controlling, by the computer system, a serving of the ad using the at least one of the (A) one or

more terms and (B) one or more phrases stored in association with the ad as the targeting

information, no patentable weight is given to the bolded section. The claim language "***as ad***

information stored in association with an ad, wherein the ad has a landing page document,

and wherein the landing page document belongs to a domain identified by the domain

identifier" is just the intended use of the term or phrase. The claimed step of providing is for the

obtained term or phrase and if the provided term or phrase is treated as an ad information stored

in association with an ad or not does not change the step of providing the obtained term or

phrase. Therefore, the language does not patentably differentiate the claimed step from the prior

art. It has been held that language that suggests or makes optional but does not require steps to

be performed or does not limit a claim to a particular structure does not limit the scope of a claim

or claim limitation. The following are examples of language that may raise a question as to the

limiting effect of the language in a claim:

> (A)   statements of intended use or field of use,
>
> (B)   "adapted to" or "adapted for" clauses,
>
> (C)   "wherein" clauses, or
>
> (D)   "whereby" clauses.
>
> This list of examples is not intended to be exhaustive. See also MPEP § 2111.04.

However if Examiner was to consider the limitation, Ryan also teaches as follows: in

order for web pages (12) to be selected by a user, search input obtained from one of variety of

sources is input and used along with the algorithm selected to determine search results; the result

of the search are then displayed to the user, as shown by the steps of displaying web pages, and

displaying actively suggested web pages … in order for keyword suggestion to take place ...

which search algorithm to use is selected... Ryan further teaches the novel feature which

indirectly inures to the benefit of the end user directly benefit the advertiser, because it allows for

content to be targeted in real time based upon various criteria … based upon inputs from users

and content providers, which content to show is determined; therefore, advertisements are

displayed for the user to see, simultaneously with the display of either keywords and/or web

pages (landing page) (see col. 4 lines 31-67, see also col. 30 lines 15-67)

Ryan does not teach generating creative information of the ad using the obtained at least

one of (A) one or more terms and (B) one or more phrases as content of the ad, and serving the

generated creative information of the ad, it is taught in Horowitz. Horowitz teaches the system

generates advertisements which are automatically placed on advertisement networks ... the

advertisements can be generated and distributed to traffic sources on behalf of advertisers who

have pre-determined price they are willing to pay for a designated action ... (see [0009], [0089}

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to generate the advertisement for the advertiser in Ryan's in order to automat the

selection and generation of advertisement, as in Horowitz.

Regarding claims 7, 8, 15, 16, 48, 49, 56 and 57 Ryan teaches the act of providing the

one or more terms or phrases includes populating keyword targeting information of the ad;

populating at least some content of a creative information of the ad; suggesting at least some

content of a creative of the ad to an advertiser (col. 2 lines 25-56, col. 4 lines 43-67, col. 11 line 6

to col. 12 line 67).

Regarding claim 10 and 11, Ryan does not teach generating creative information of the

ad using the obtained at least one of (A) one or more terms and (B) one or more phrases as

content of the ad, and serving the generated creative information of the ad, it is taught in

Horowitz. Horowitz teaches the system generates advertisements which are automatically placed

on advertisement networks ... the advertisements can be generated and distributed to traffic

sources on behalf of advertisers who have pre-determined price they are willing to pay for a

designated action ... (see [0009], [0089} Therefore, it would have been obvious to one of

ordinary skill in the art at the time of the invention to generate the advertisement for the

advertiser in Ryan's in order to automat the selection and generation of advertisement, as in

Horowitz.

Response to Arguments

Applicant's arguments filed September 8, 2009 have been fully considered but they are

not persuasive. Applicant argues that Ryan as amended does not teach providing the obtained at

least one or more terms or phrases (which are obtained by aggregating search query information

which led to a user selection of the ad's linked "landing page) **as ad information stored in**

association with an ad. How can, obtaining one of the terms or phrases (that was provided as a

search query) and providing the term or phrase be more than the term or phrase itself? If the term

that was received as search term is provided, it is just the search term. The language "as ad

information stored in association with an ad where the ad has a landing page document, and

wherein the landing page document belongs to a domain identified by the domain identifier" is

just an intended use of the obtained or provided search term or search query. There is no addition

step claimed that could turns the search term or search query into an ad, therefore no patentable

weight could be given to the claimed language. It has been held that Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation (MPEP §2106 II C). The claim recites the step of obtaining and providing the term or phrase (i.e., the term or phrase that was received as a search query) using the received domain identifier.

Applicant also argues that Ryan does not teach controlling by the computer system the serving of the ad using at least one of ... stored in association with the ad as the **target information**. Examiner again points out that even thought the claim recites the serving of the ad the claim does not recite an ad. As indicated above the claim only recites the obtaining of the term or phrase and providing the obtained term or phrase. Whether the term is provided as an ad information or not, it is still a term or phrase. Therefore, there is no ad to be served. The language "as the targeting information" is just an intended use and no patentable weight is given.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The

examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622